

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte: DAVID MCLEOD AND DOUGLAS MCCOLLUM

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Application No. 10/081,506

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was received electronically at the Board of Patent Appeals and Interferences on October 3, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

**APPEAL BRIEF**

A review of the file indicates that on November 29, 2006, appellants filed an Appeal Brief in response to a Final Rejection mailed July 28, 2005. Accordingly, the Appeal Brief filed on November 29, 2006 does not comply with the rules under 37 CFR 41.37(c)(1).

37 CFR § 41.37(c)(iii) states:

(iii) *Status of claims*. A statement of the status of all the claims in the proceeding (*e.g.*, **rejected, allowed or confirmed, withdrawn, objected to, canceled**) **and an identification of those claims that are being appealed.**

(vi) *Grounds of rejection to be reviewed on appeal.* A concise statement of **each** ground of rejection presented for review.

(vii) *Argument.* The contentions of appellant with respect to **each** ground of rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown. **Each ground of rejection must be treated under a separate heading.** For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for patentability of the claim.

The following sections are defective in the Appeal Brief filed November 29, 2006:

(1) "Status of Claims" as set forth in 37 CFR § 41.37(c)(1)(iii), "Appellants hereby appeal the Final Rejection of claims 9, 14 and 17 and their dependents." Appellant must address the status of each rejected claim, irrespective of their dependency;

(2) "Grounds of rejection to be reviewed on appeal" as set forth in 37 CFR § 41.37(c)(1)(vi), Claims 10, 12, 15 and 16 were not addresses; and

(3) "Arguments," as set forth in 37 CFR § 41.37(c)(1)(vii). The Appeal Brief (pg. 7) indicates that claims 9, 14 and 17 were rejected in the Final Rejection July 28, 2005 over a combination of Hill et al (6,493,970) Lumpe (6,592,176). This is inaccurate.

**CLAIMS APPENDIX**

A review of the application reveals that claim 17 in the appendix of the Appeal Brief (pg. 19, ln 12-16) is not consistent as amended in the Amendment (pg. 7, ln. 14-21) filed on May 17, 2005.

Appropriate correction is required.

**EXAMINER'S ANSWER**

**NEW GROUND OF REJECTION**

On March 22, 2007, an Examiner's Answer was mailed. The Examiner's Answer included a new ground of rejection, where Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hill et al. in view of Miyazaki et al, Hsieh and Lumpe et al. The reference Lumpe (6,592,176) was not cited in the Final Rejection mailed July 28, 2005.

When a new ground of rejection is introduced in the Examiner's Answer, the Examiner is required to obtain approval of the Technology Center Director or his/her designee. Further, any new ground of rejection is required to be prominently identified, eg., a separate heading with all capitalized letters. See MPEP § 1207.02(A)(6)(d).

**CONCLUSION**

Accordingly, it is


**ORDERED** that the application is returned to the Examiner:

- 1) hold the Appeal Brief filed on November 29, 2006 defective;
- 2) to notify appellants to file a Supplemental Appeal Brief in compliance with 37 CFR § 41.37;
- 3) vacate the Examiners Answer mailed March 22, 2007;

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- 4) for the examiner to consider the Supplemental Appeal Brief and issue a new Examiner's Answer or Supplemental Examiner's Answer to include any new Grounds of Rejection (with appropriate signature) whichever is appropriate ; and
- 5) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
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